

**REMARKS**

**Claim Rejections**

Claims 1, 3, 6-9 and 12-14 are rejected under 35 U.S.C. § 102(b) as being anticipated by Ushiro et al. (U.S. 4,939,588). Claims 2, 4, 5, 10 and 11 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Ushiro et al. and further in view of Holliday (U.S. 3,957,358).

**Drawings**

It is noted that the Examiner has accepted the drawings as originally filed with this application.

**Claim Amendments**

By this Amendment, Applicant has amended claims 1, 3, 8, 12 and 13 of this application. It is believed that the amended claims specifically set forth each element of Applicant's invention in full compliance with 35 U.S.C. § 112, and define subject matter that is patentably distinguishable over the cited prior art, taken individually or in combination.

The primary reference to Ushiro et al. teaches an electronic copying machine for making a hard copy of a remote original having a housing (1) having slits (1a) receiving air, exhaust slits (1b) discharging air, and a slit (1d) into which paper is inserted, and a plurality of lenses (11, 12, 14, and 16) located in the housing, wherein the lenses (11, 12, and 14) are set for converging the light from a halogen lamp (10) as a thin vertical line of light; then the light is reflected by a fixed mirror (15), and the vertical line of light is expanded in width by lens (16) and directed to a scanning mirror (17) for scanning the front surface of the remote writing board (65), as described on column 4, lines 37-44. In the Office Action, the Examiner regards the slits (1a and 1d) as the rectangular openings at two opposite ends of the frame of the present invention. However, the rectangular openings in the frame of the present invention are completely different from the slits in Ushiro et al.

Ushiro et al. states, column 2, lines 38-40:

As is shown in FIG. 1, the housing 1 is formed with slits 1a in its front wall for admitting cool air and with exhaust slits 1b in its top wall for exhausting heated air.

Ushiro et al. states, column 3, lines 17-22:

In the back wall of the housing 1, there is formed a delivery slit 1d for the heat sensitive paper 22. Between the heat sensitive paper 22 and the delivery slit 1d, there are transporting rollers 33a and 33b for transporting the heat sensitive paper 22 and a cutter 34 for cutting off the heat sensitive paper 22.

In Ushiro et al., the slits (1a and 1d) are for admitting cool air and delivering the heat sensitive paper, respectively, as described on column 2, lines 38-39 and column 3, lines 17-18. While in the present invention, the rectangular openings at two opposite ends are for light incidence and light escape respectively. In other words, the device of the present invention is to condense the light from a light source outside the device, but the light source in Ushiro's patent is the halogen lamp, which is an endogenous light source.

In addition, according to the above descriptions and referring to Figs. 3 and 4 of Ushiro's patent, the condenser lens system (13), which comprises lenses (11, 12), and the cylindrical lens (14) are for condensing the light from the halogen lamp (10), then the light is reflected by the fixed mirror (15), and expanded in width by lens (16) and directed to the scanning mirror (17) for scanning the front surface of the remote writing board (65). It is different from Claim 8 of the present invention, since the optical path device comprises "a light condensing device receiving light reflected by said reflecting device and condensing it for imaging". The purpose of reducing unwanted intermixing of data from other lines for enhancing the MTF of the scanner and further letting the brightness be more uniform according to the present invention is not achievable with the design in Ushiro's patent.

Ushiro et al. do not teach a hollow frame having first and second rectangular openings located on opposing ends thereof; the first rectangular opening receiving a light; nor do Ushiro et al. teach the second rectangular opening discharging a condensed and imaged light.

It is axiomatic in U.S. patent law that, in order for a reference to anticipate a claimed structure, it must clearly disclose each and every feature of the claimed structure. Applicant submits that it is abundantly clear, as discussed above, that Ushiro et al. do not disclose each and every feature of Applicant's amended claims and, therefore, could not possibly anticipate these claims under 35 U.S.C. § 102. Absent a specific showing of these features, Ushiro et al. cannot be said to anticipate any of Applicant's amended claims under 35 U.S.C. § 102.

The secondary reference to Holliday teaches a viewer for microreproduction on a transparent film and is cited for teaching the housings, base member and lens support device being made of metal, wood, or plastic material.

Holliday does not teach a hollow frame having first and second rectangular openings located on opposing ends thereof; the first rectangular opening receiving a light; nor does Holliday teach the second rectangular opening discharging a condensed and imaged light.

Even if the teachings of Ushiro et al. and Holliday were combined, as suggested by the Examiner, the resultant combination does not suggest: a hollow frame having first and second rectangular openings located on opposing ends thereof; the first rectangular opening receiving a light; nor does the combination suggest the second rectangular opening discharging a condensed and imaged light.

It is a basic principle of U.S. patent law that it is improper to arbitrarily pick and choose prior art patents and combine selected portions of the selected patents on the basis of Applicant's disclosure to create a hypothetical combination which allegedly renders a claim obvious, unless there is some direction in the selected prior art patents to combine the selected teachings in a manner so as to negate the patentability of the claimed subject matter. This principle was enunciated over 40 years ago by the Court of Customs and Patent Appeals in In re Rothermel and Waddell, 125 USPQ 328 (CCPA 1960) wherein the court stated, at page 331:

The examiner and the board in rejecting the appealed claims did so by what appears to us to be a piecemeal reconstruction of the prior art patents in the light of appellants' disclosure. ... It is easy now to attribute to this prior art the knowledge which was first made available by appellants and then to assume that it would have been obvious to one having the ordinary skill in the art to make these suggested reconstructions. While such a reconstruction of the art may be an alluring way to rationalize a rejection of the claims, it is not the type of rejection which the statute authorizes.

The same conclusion was later reached by the Court of Appeals for the Federal Circuit in Orthopedic Equipment Company Inc. v. United States, 217 USPQ 193 (Fed.Cir. 1983). In that decision, the court stated, at page 199:

As has been previously explained, the available art shows each of the elements of the claims in suit. Armed with this information, would it then be non-obvious to this person of ordinary skill in the art to coordinate these elements in the same manner as the claims in suit? The difficulty which attaches to all honest attempts to answer this question can be attributed to the strong temptation to rely on hindsight while undertaking this evaluation. It is wrong to use the patent in suit as a guide through the maze of prior art references, combining the right references in the right way so as to achieve the result of the claims in suit. Monday morning quarterbacking is quite improper when resolving the question of non-obviousness in a court of law.

In In re Geiger, 2 USPQ2d, 1276 (Fed.Cir. 1987) the court stated, at page 1278:

We agree with appellant that the PTO has failed to establish a *prima facie* case of obviousness. Obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching suggestion or incentive supporting the combination.

Applicant submits that there is not the slightest suggestion in either Ushiro et al. or Holliday that their respective teachings may be combined as suggested by the Examiner. Case law is clear that, absent any such teaching or suggestion in the prior art, such a combination cannot be made under 35 U.S.C. § 103.

Neither Ushiro et al. nor Holliday disclose, or suggest a modification of their specifically disclosed structures that would lead one having ordinary skill in the art to arrive at Applicant's claimed structure. Applicant hereby respectfully submits that no combination of the cited prior art renders obvious Applicant's new claims.


**Summary**

In view of the foregoing amendments and remarks, Applicant submits that this application is now in condition for allowance and such action is respectfully requested. Should any points remain in issue, which the Examiner feels could best be resolved by either a personal or a telephone interview, it is urged that Applicant's local attorney be contacted at the exchange listed below.

Respectfully submitted,

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